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| 10/650,577      | 08/27/2003  | Hakam Madi           |                     | 8230             |

7590 07/28/2008  
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| EXAMINER |
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SENSENIG, SHAUN D

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| ART UNIT | PAPER NUMBER |
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4176

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07/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/650,577 | <b>Applicant(s)</b><br>MADI, HAKAM |  |
|                              | <b>Examiner</b><br>Shaun Sensenig    | <b>Art Unit</b><br>4176            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 4, 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Claim Objections*

1. **Claims 1-7** are objected to because of the following informalities: the term “for which to be used” in claim 1 appears to have been intended to be --for use--.

Appropriate correction is required.

2. **Claim 4** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph), or, in other words, that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

When, as here, an independent claim recites a particular method, a dependent claim drawn to an apparatus capable of performing the method of the independent claim is not a proper dependent claim if the apparatus might be used in other ways, since the dependent claim (the apparatus) could conceivably be infringed without infringing the basic claim (the method), in violation of the infringement test for proper dependency of claims. See MPEP § 608.01(n)(III).

Applicant is required to cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 112, First Paragraph***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-7** are rejected under 35 U.S.C. 112, first paragraph, as being a single means claim. A single means claim is a claim in which a means recitation does not appear in combination with another recited element of means. A single means claim covers every conceivable means for achieving the stated purpose and is held as nonenabling for the scope of the claim because the specification discloses at most only those means known to the inventor. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197. See MPEP § 2164.08(a). Applicant's claim 1 recites "software means for use by retailers who own computer systems", but does not recite any additional steps or means.

***Claim Rejections - 35 USC § 112, Second Paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-7** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The term "main" in claim 1 is a relative term which renders the claim indefinite. The term "main" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoutenburg et al. (Pub. No. Us 2002/0156683 A1) (hereafter referred to as Stoutenburg).**

10. In regards to **Claim 1**, Stoutenburg discloses:

A lottery calculating device/software comprising: Computer software means for use by retailers who own computer systems and/or integrated information systems with the main state lottery sale programs. ([0049])

11. In regards to **Claim 2**, Stoutenburg discloses:

A lottery calculating device according to claim 1 wherein the software apparatus minimizes the errors in preparing a total for all sold scratch tickets per shift electronically. ([0101])

12. In regards to **Claim 3**, Stoutenburg discloses:

A lottery calculating device according to claim 1 wherein the device maintains a hand held device to register the game number and the value per ticket for that game, the size of the bundle and the number of the last ticket sold thereof. ([0049], and [0113], lines 14-16)

13. In regards to **Claim 4**, Stoutenburg discloses:

A lottery calculating device according to claim 1 wherein the device functions are maintained managed and programmed through software. ([0049], and [0066], lines 10-11)

14. In regards to **Claim 5**, Stoutenburg discloses:

A lottery calculating device according to claim 1 wherein a device calculates lottery scratch tickets. (Fig. 13D, and [0216])

15. In regards to **Claim 6**, Stoutenburg discloses:

A lottery calculating device according to claim 1 wherein the device will generate a report containing the time, date, total tickets sold per game, the value of tickets sold per game and the grant total of all tickets sold. (Fig. 13D, [0091], and [0216])

16. In regards to **Claim 7**, Stoutenburg discloses:

A lottery calculating device according to claim 1 wherein the software of the device can be accessed on the internet. ([0223], lines 2-6)

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hedman et al. (Pub. No. 2004/0015411 A1), Sullivan (Patent No. US 6,663,105 B1), and Sisca (Patent No. 5,988,499).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. S./  
Examiner, Art Unit 4176  
July 23, 2008

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 4176